REMARKS/ARGUMENTS

1.)   Claim Amendments

The Applicants have amended claims 50, 53, 54, 56, 57, 67, 70, 71, 73, 74, 83, 86 and 87, and cancelled claims 51, 52, 58-66, 68, 69, 82, 84, 85 and 98; no new matter has been added. Accordingly, claims 50, 53-57, 67, 70-81, 83 and 86-97 remain pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.)   Examiner Objections – Specification

The Examiner objected to the title of the invention. The Applicant has amended the title as suggested by the Examiner.

3.)   Examiner Objections - Claims

The Examiner objected to claims 50, 58, 66-67, 82-83 and 98 for certain informalities. The Applicants have amended those claims, as suggested by the Examiner, to specify the underlying terms of all acronyms.

4.)   Claim Rejections – 35 U.S.C. §102(b)

The Examiner rejected claims 50-98 as being anticipated by Wallentin, *et al.* (U.S. Patent No. 6,594,238). The Applicants have amended claim 50 to include the limitations of claims 51 and 52; amended claim 67 to include the limitations of claims 68 and 69; and amended claim 83 to include the limitations of claims 84 and 85; accordingly, claims 51, 52, 68, 69, 84 and 85 have been cancelled. Furthermore, in order to expedite prosecution, the Applicants have cancelled claims 58-66, 82, 84, 85 and 98, without prejudice or disclaimer. The Applicants traverse the rejection of claims 50, 53-57, 67, 70-81, 83 and 86-97.

It is important to remember that anticipation requires that the disclosure of a single piece of prior art reveals **every** element, or limitation, of a claimed invention. Furthermore, the limitation that must be met by an anticipatory reference are those set forth in each statement of function in a claims limitation, and such a limitation cannot be

met by an element in a reference that performs a different function, even though it may be part of a device embodying the same general overall concept. Wallentin fails to disclose each and every limitation of claims 50, 53-57, 67, 70-83 and 86-97 and, therefore, those claims are not anticipated thereby.

Claim 50, as amended to include the limitations of claims 51 and 52, recites:

> 50.   A method in a User Equipment (UE) for initiating a data transfer from the UE in a Universal Mobile Telecommunications System (UMTS) terrestrial radio access network (UTRAN), wherein the UTRAN comprises at least one Radio Network Controller (RNC) connectable to the UE that is capable of being in the states UTRAN Registration Area Paging Channel (URA PCH), Cell Paging Channel (CELL PCH) or Cell Dynamic Host Configuration (CELL DCH), said method comprising the steps of:
> introducing delay reducing information in a data transfer initiating message by the UE;
> transmitting the data transfer initiating message by the UE;
> receiving a message from the RNC comprising information for transferring the UE from the URA PCH or the CELL PCH state directly to the CELL DCH state by means of the delay reducing information in the data transfer initiating message;
> wherein the data transfer initiating message is an uplink cell update message transmitted by a UE; and,
> wherein the delay reducing information comprises information if the traffic volume of the data to be transmitted is above a pre-configured threshold. (emphasis added)

The Applicants' invention is characterized by a data transfer initiating message including delay reducing information. In particular, the data transfer initiating message is an uplink cell update message transmitted by a User Equipment, wherein the delay reducing information comprises information if the traffic volume of the data to be transmitted is above a pre-configured threshold. Wallentin fails to disclose at least those aspects of the claimed invention.

Wallentin does teach a method of adapting a connection state in a mobile communication system wherein a decision to change state is based on a value of traffic volume. The solution taught by Wallentin apparently assumes that knowledge of the traffic volume is available in the network node that makes the decision to change state; there does not appear to be any teaching in Wallentin of how such information is

acquired by the network node. According to Applicants' claimed invention, it is the User Equipment that determines whether traffic volume of the data to be transmitted exceeds a pre-configured threshold, which is indicated in the data transfer initiation message transmitted by the User Equipment.

The Applicants invention solves the problem of how to get traffic volume information to a Radio Network Controller (RNC) without having to explicitly signal the traffic volume. Instead, the User Equipment performs a comparison between the traffic volume and a pre-configured threshold and then the outcome of the comparison is signaled to the RNC in the data transfer initiating message; signaling only the outcome of the comparison against a threshold requires less bandwidth than explicitly signaling the traffic volume. Wallentin fails to teach or suggest that mechanism for triggering the transfer of the User Equipment directly to the CELL DCH state. Accordingly, Wallentin fails to anticipate claim 50 as amended to include the limitations of claims 51 and 52.

Whereas independent claims 67 and 83 recite limitations analogous to those of claim 50, they are also not anticipated by Wallentin. Furthermore, whereas claims 53-57, 70-81 and 86-97 are dependent from claims 50, 67 and 83, respectively, and include the limitations thereof, those claims are also not anticipated by Wallentin.

* * *

CONCLUSION

In view of the foregoing amendments and remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 50, 53-57, 67, 70-81, 83 and 86-97.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,

Roger S. Burleigh
Registration No. 40,542

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Ericsson Inc.
6300 Legacy Drive, M/S EVR 1-C-11
Plano, Texas 75024

(972) 583-5799
roger.burleigh@ericsson.com